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TOWNSEND and TOWNSEND and CREW LLP

By:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

JONATHAN J. HULL et al.

Application No.: 09/905,036

Filed: July 12, 2001

For: TECHNIQUES FOR TARGETING  
INFORMATION TO USERS

Customer No.: 20350

Confirmation No. 2402

Examiner: Linh Black

Technology Center/Art Unit: 2163

Statement in Support of Request for Pre-  
Appeal Brief Conference

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Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, which is submitted herewith along with a Notice of Appeal.

Applicant respectfully requests review of the Office action mailed November 1, 2006, that rejected claims 1-13 under 35 U.S.C. 102(e) as being anticipated by Ferguson et al. U.S. Patent No. 6,820,094. Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson in view of Herz U.S. Patent No. 6,460,036. Claims 15-44 were rejected upon the same grounds as claims 1-14. The action was made final because Applicant's response filed August 14, 2006 ("response to non-final") was deemed unpersuasive as to overcoming rejections

made in a non-Final Office action of April 11, 2006. The examiner repeated her grounds for rejection and included a response to arguments presented in the response to non-final.

It is earnestly believed that these rejections are unfounded for at least the reasons set forth below, and review of the rejections is respectfully requested.

### **OVERVIEW OF THE PENDING CLAIMS**

Stated informally, the pending claims recite a method for presenting information in a document. A first section of the document is identified. A first set of information objects in the first section are processed to determine a degree of relevancy with objects in a second set of information objects. At least one of the objects in the second set of information objects is of a type that is different from the objects in the first set of information objects. Third information objects are then selected from the second set of information objects based on the degree of relevancy determined above, and the are displayed to the user.

At a very high level view, the pending claims are directed to retrieving information objects relevant to portions of a first document. Independent claims 1, 15, and 29 recite similar limitations. Independent claims 14, 28, and 42 recite similar limitations, which are different from the limitations of claims 1, 15, or 29.

### **INDEPENDENT CLAIMS 1, 15, AND 29**

#### **Response to Applicant's Arguments**

The examiner responded to arguments presented in the response to non-final regarding the "processing information objects" and maintained her rejection, citing col. 1, line 64 to col. 4, line 3, col. 3, line 56 to col. 4, line 29, col. 8, lines 22-44, and col. 13, line 52 to col. 14, line 10, and Table I in col. 19 of the Ferguson reference.

Ferguson teaches in column 8 lines 22-44 that information in a "seed" document is analyzed to extract category criteria, which criteria are then matched against existing and new documents. As best understood, the examiner appeared to assert that Ferguson's existing and new documents taught the recited "document" and that Ferguson's seed document taught the recited "second set of information objects."

The examiner responded to arguments presented in the response to non-final regarding the “selecting a third set” and maintained her rejection, citing col. 11, lines 55-65 and col. 13, line 52 to col. 14, line 17 of Ferguson.

The claim limitations in question recite:

processing information objects in the first set of information objects and information objects in a second set of information objects to determine a degree of relevancy information indicating the relevancy of information objects in the second set of information objects to information objects in the first set of information objects; and selecting a third set of one or more information objects from information objects in the second set of information objects based upon the degree of relevancy information determined for information objects in the second set of information objects, wherein information objects in the third set of information objects store information to be output to the user when the first document is being displayed to the user

Clearly, the “selecting” step involves selecting objects from the second set of information (i.e., the third set of information) and displaying them.

However, the examiner stated in her response to Applicant’s argument that “Based on the level of relevancy of at least one of the second document type objects [presumably Ferguson’s seed document, as discussed above] ..., the user can view the identified documents as small icons, large icons, ... which the Examiner interprets as the third set... .” Ferguson teaches viewing “identified documents,” as the examiner observes, which are documents identified from a search, see column 13, lines 16-32.

However, the claim recites outputting to the user third information objects selected from the second set of information. Assuming *arguendo* that Ferguson’s seed document corresponds to the recited second set of information, then Ferguson does not teach selecting third information objects from the seed document based on degree of relevancy and outputting them to the user. Instead, Ferguson teaches viewing the documents themselves.

Taking into account the description of his seed document, Ferguson appears to describe that the categories in his seed document each has an assigned smart folder (col. 13, lines 57-59). However, this only teaches that there is a smart folder for each category, not that the categories are selected based on degree of relevance. Therefore, contrary to the examiner’s interpretation of Ferguson, the prior art does not show outputting third information objects selected from the second set of information.

Further Distinction: “relevance information”

The examiner appears to have cited Table I in column 19 of Ferguson for teaching “relevance score,” presumably equating that to the recited:

... degree of relevancy information indicating the relevancy of information objects in the second set of information objects to information objects in the first set of information objects ...

However, Ferguson’s relevance score is “the relevance score the document has to the query.” In other words, Ferguson’s relevance score relates to relevance to a query, not “relevancy of information objects in the second set of information objects to information objects in the first set of information objects.”

Further Distinction: “wherein the second type is different from the first type”

A further claim limitation recites:

... wherein the second set of information objects comprises at least one information object comprising information of a second type, wherein the second type is different from the first type [of the first information objects], ...

Ferguson does not teach determining degree of relevancy between objects of different types. A review of Ferguson does not appear to reveal any such comparison.

**INDEPENDENT CLAIMS 14, 28, AND 42**

These claims recite CPIO (content provider information objects) and UDIO (user document information objects). The rejection of claim 14 appears to be essentially a “cut-and-paste” of the text of the rejection of claim 1. The examiner cited Herz apparently for teaching CPIOs and UDIOs. However, the limitations of independent claim 14 (and of independent claims 28 and 42) do not match the limitations of claim 1. This observation was brought to the attention of the examiner in the response to non-final; however, the final Office action repeats the same rejection.

Claim 14 substantively recites in part:

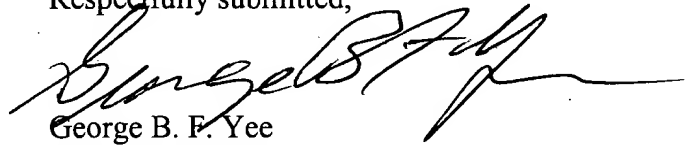
identifying a plurality of selection techniques for determining degree of relevancy information ... the plurality of selection techniques comprising a first selection technique and a second technique, wherein the first technique compares contents of the UDIOs and the CPIOs, wherein the second technique determines relevancy of the UDIOs and the CPIOs to one or more concepts of interest to a user;

for each selection technique in the plurality of selection techniques, applying the selection technique ... to generate degree of relevancy information ...;

At least these foregoing limitations of claim 14 appear not at all to have been examined. For this reason, the finality of the latest Office action should be withdrawn.

In addition, the foregoing discussion in connection with independent claims 1, 15, and 29 applies to any claim limitations deemed to correspond to limitations in claim 1.

Respectfully submitted,



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